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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/565,260	08/02/2006	Carmen Kuhl	IHN.060.WUS	9609
10888	7590	08/16/2011		
Hollingsworth & Funk 8500 Normandale Lake Blvd., Suite 320 Minneapolis, MN 55437				
EXAMINER				
SYED, NABIL H				
ART UNIT		PAPER NUMBER		
2612				
NOTIFICATION DATE		DELIVERY MODE		
08/16/2011		ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

tdotter@hfiplaw.com  
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**Office Action Summary****Application No.**

10/565,260

**Applicant(s)**

KUHL ET AL.

**Examiner**

NABIL SYED

**Art Unit**

2612

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 28 February 2011.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,3,5-14,21,26,28,29,31 and 33-36 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3,5-14,21,26,28,29,31 and 33-36 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ ~~Copies of the certified copies of the priority documents have been received in this National Stage~~  
application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
- Paper No(s)/Mail Date \_\_\_\_\_

- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

1. The following is a no-final office action in response to the RCE filed 2/28/11. Amendments received on 2/28/11 have been entered. Claims 12, 15-20, 22-24 and 27 were previously cancelled. As per applicant claims 4, 25, 30, 32 and 37 are cancelled. Accordingly claims 1, 3, 5-14, 21, 26, 28, 29, 31 and 33-36 are pending.

### Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3. Claims 1, 3, 5-14, 21, 26, 28, 29, 31, 33-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Amtmann et al. (US Pub 2005/0218230) in view of Applicant Admitted Prior Art (AAPA) and further in view of Arisawa et al. (WO 02/071325) (Note, the rejection is based on the WIPO publication (WO 02/071325) and the US Publication (US 2003/0141989) is provided as an English translation of the WIPO publication).

As of claims 1, 14 and 28, Amtmann discloses a reader device (via portable device 1 identifying data carrier 13; see abstract). Amtmann further discloses that portable device 1 comprises a reader logic unit configured to cause the reader device to

operate in a reader operation mode wherein the reader device transmits interrogation signals to detect and communicate with transponders (via a communication station configuration 10 interrogating data carriers 13; see paragraph [0018]; also see fig. 1) and by simulating a radio frequency identification tag to communicate with another radio frequency identification reader (via communication station configuration 10 communicating with an external communication station using PROT1, wherein external communication station 14 transmits a signal to the communication station 40, and communication station 40 receives the signal and enables communication between the communication station configuration 10 and an external station, so it is interpreted that when the station 40 uses the communication station configuration 40 to communicate with an external communication station 14 it is simulating a tag to communicate with another reader; see fig. 1; also see paragraph [0032], lines 15-30).

Amtmann further discloses that the portable device 1 further comprises an associated transponder logic unit (via data carrier configuration 11; see fig. 1). Amtmann further discloses that the data carrier configuration (transponder logic unit) is provided and designed for contact-less communication with at least one communication station 14 (other readers) external to the portable device 1 (see paragraph [0018]; also see fig. 1).

Further with respect to a common radio frequency interface, Amtmann discloses that two transmit receive means 21 and 27 may alternatively be formed by a common transmit/receive circuit configuration.

Further with regards to a reader device operating as a reader to detect and communicate with radio frequency transponder and simulating as a radio frequency identification tag, AAPA discloses a portable terminal 1, which is configured to operate in a reader operation mode by transmitting interrogation signals to detect and communicate with radio frequency transponders (700) and by simulating a radio frequency identification tag to communicate with another radio frequency identification reader (via terminal 2; see fig. 1; also see page 4, lines 15-35 of specification of the present application)

From the teaching of AAPA it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the system of Amtmann to include the functions of communicating as a reader to interrogate tags and functioning as tag in a reader device as taught by AAPA in order to allow a user to carry a single device which can be used to interrogate tags to retrieve information or provide user information stored in the device to other interrogators for access or authentication purposes.

However the combination Amtmann and AAPA fails to explicitly disclose the limitation regarding a switching unit as claimed in the present application.

Arisawa discloses a reader device (via cell phone 102; see fig. 3; also see paragraph [0032]), which comprises a reader logic unit (via R/W function section 154) to operate in a reader operation mode by transmitting interrogation signals to detect and communicate with IC cards (transponders; via cell phone using r/w function section 500 to communicate with IC cards; see fig. 2; also see paragraph [0002], [0003] and [0035]).

Arisawa further discloses that the transmission and receiving antennas for a card and reader/writer can be a single common antenna (see paragraph [0040]). Arisawa further discloses a transponder logic unit (via card function 300) configured to cause the reader device to operate in a show communication mode wherein the reader device acts as a passive transponder (Arisawa discloses that when the cell phone 102 uses the card function section 400, it receives a carrier wave and generates operating power for the IC chip 300 to communicate with other reader/writer; see paragraphs [0033] and [0003]). Arisawa further discloses a switching unit configured to switch between the reader operation mode (R/W function 500) when the reader device is powered and the show communication operation mode (card function mode 400) when the reader device is not powered (Arisawa discloses switching unit (via switches 162 and 164), which are used to make the device operate in the card function 300 (via the cell phone 102 using the rectifier to receive power) even when the battery power is not supplied to the IC chip 300 (see fig. 2 and 5) and when the battery power is supplied to the cell phone the R/W function can be used; (see fig. 7; also see paragraph [0043]-[0047])

Hence the prior art includes each element claimed, although not necessarily in a single prior art reference, with the only difference between the claimed invention and the prior art being the lack of actual combination of the elements in a single prior art reference.

In combination, the combination of Amtmann, AAPA performs the same function as it does separately of switching a device between a reader operation mode and a tag

operation mode. Arisawa performs the same function as it does separately of allowing the tag to be operational even when the device it is embedded in is not powered.

Therefore one of ordinary skill in the art could have combined the elements as claimed by known methods, and that in combination, each element merely performs the same function as it does separately.

The result of the combination would have been predictable and resulted in modifying the combination of Amtmann and AAPA to include the functionality of communicating with a tag even when the device in which the tag is embedded is not powered up.

As of claims 3, 5, 29 and 31, Arisawa discloses that the card function is operable as a passive transponder and independently from a power supply of the mobile device (via battery 160) to which the IC chip 300 is coupled and is energized by an interrogation signal (see paragraph [0033]).

As of claims 6-8 and 21, Amtmann discloses that the data carrier configuration 11 (transponder logic unit) comprises a non-volatile memory 30 (see fig. 1; also see paragraph [0020]), since the memory is non-volatile, and it is well known that non-volatile memory includes read-only memory, so the data carrier configuration 11 will act as a read-only transponder. Amtmann further discloses that data content received from external communication station 14 can be stored in the memory 30, so the memory 30 can be designed as a configurable memory (see paragraph [0020]).

As of claims 9, Amtmann discloses that the activation means 33 selects one of the two configuration of the portable device, namely data carrier configuration 11

(transponder logic) and communication station configuration 10 (reader logic) (see paragraph [0023]). Hence comprising the switch unit as claimed in present claims.

As of claims 10 and 33, Arisawa discloses that the passive tag 14 communicates with the controller 18 (interrogator) even when the mobile device 102 (reader device) is not powered up (energized; see paragraph [0033] and [0045]; also see figs. 5-7).

As of claims 11 and 34, Amtmann discloses that the transmit/receive circuit provide signals required for operation of the reader device in the reader operation mode and the show communication mode (see paragraph [0038]). Arisawa further discloses that the transmit/receive circuit provide signals required for operation of the reader device in the reader operation mode and the show communication mode (see paragraph [0040]).

As of claims 12, 13, 35, and 36, Amtmann discloses that the portable device 1 supports near field communication standard, wherein reader device is operable with a passive communication mode and in active communication mode is reader operation mode (via portable device 1 communicating with other reader devices/external communication station 14 and communicating with other tags 13; see fig. 1; also see paragraph [0021]). Amtmann further discloses that the portable device is operable with a show communication mode in transponder operation mode (via data carrier configuration 11 receiving signals from external communication station and transmitting a reply back). AAPA further discloses that the reader device supports near field communication and the reader device is operable with a passive communication mode in the reader operation mode (when reader device is communicating with tags; see



specification, page 4, lines 10-15) and reader device is operable with an active communication mode (when reader device is communicating with other readers; see specification, page 4, lines 15-27).

As of claim 26, Amtmann discloses that the portable device 1, is in the form of a cell phone, so the device is able to communicate via a public land mobile network (see paragraph [0015]).

### **Response to Arguments**

4. Applicant's arguments with respect to all claims have been considered but are moot in view of the new ground(s) of rejection.

### **Conclusion**

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to NABIL SYED whose telephone number is (571)270-3028. The examiner can normally be reached on M-F 7:30-5:00 alt Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brian Zimmerman can be reached on (571)272-3059. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/NABIL H SYED/  
Primary Examiner  
Art Unit 2612

N.S